REMARKS

After entry of this amendment, claims 49-55 and 59 will pending in this application. Claims 49-55 have been amended to clarify the method utilized to screen material samples. In particular, claim 49 has been amended to indicate that a responsive force exerted by the material is monitored with a sensor. Claims 50 and 51 have been amended to more clearly indicate that the force is measured as a function of displacement and as a function of time, respectively. Claim 52 has been amended to clarify how the properties of the materials can be measured and also to include a larger of number of properties that can be determined. Claims 53-55 have been amended to clarify greater numbers of materials can perturbed at one time. Claim 59 has been added to cover additional subject matter more precisely; namely, that the probes suitable for use in the present method include those that include a test fixture. Support for this addition can be found at page 10, line 1. No new matter has been added.

The foregoing amendments are taken in the interest of expediting prosecution and there is no intention of surrendering any range of equivalents to which Applicant would otherwise be entitled in view of the prior art.

By amending the application, the Applicants do not concede that the patent coverage available to them would not extend as far as the original claim. Rather, Applicants reserve the right to file a continuation application to pursue the breadth of the claims as filed. Applicants believe that the Examiner has not made a sufficient showing of inherency of the teachings of the asserted prior art, especially given the lack of teachings in the cited references of the properties that Applicants have recited in their claims.

Further, by the present amendment, it does not follow that the amended claims have become so perfect in their description that no one could devise an equivalent. After amendment, as before, limitations in the ability to describe the present invention in language in the patent claims naturally prevent the Applicants from capturing every nuance of the invention or describing with complete precision the range of its novelty or every possible equivalent. See, Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 62 USPQ2d 1705 (2002). Accordingly, the foregoing amendments are made specifically in the interest of expediting prosecution and there is no intention of surrendering any range of equivalents to which Applicants would otherwise be entitled.

Obviousness-Type Double Patenting Rejections

The Examiner rejected claims 49-55 as being unpatentable in view of the judicially created doctrine of obviousness-type double patenting over claims 1-12 of U.S. Patent No. 6,182,499 to McFarland et al. ("McFarland"); over claim 4 of U.S. Patent No. 6,438,497 to Mansky et al. ("Mansky"); and over claims 1-8 of U.S. Patent No. 6,393,859 to Matsiev et al. ("Matsiev"). This rejection is traversed in view of the submitted terminal disclaimer and the associate power of attorney. Applicants respectfully request that this rejection be withdrawn.

Rejection of claims 49-55 under 35 U.S.C. §112, second paragraph

The Examiner rejected claims 49-55 under 35 U.S.C. §112, second paragraph as indefinite. In view of the amendment to claims herein, Applicants believe that this rejection is moot. The Examiner is invited to contact the Applicants' Attorney to discuss possible amendments should the Examiner feel that it would further prosecution of this case.

Rejection of claims 49-55 under 35 U.S.C. §§102(e)

The Examiner rejected claims 49-55 under 35 U.S.C. § 102(e) as being anticipated by McFarland. This rejection is traversed.

Contrary to the assertion of the Examiner, McFarland does not monitor with a sensor a force exerted on the probe by the material. Rather, McFarland utilizes electrical pulses and changes in electrical pulses to measure changes in resonance frequency of a resonator. The Examiner's attention is drawn to column 12, lines 7 where McFarland describes the operation of the invention:

> In the embodiment illustrated in FIG. 5, a network analyzer 505, such as a HP8751A Analyzer, is used to excite the resonator oscillations and to receive the response of the oscillator at various frequencies. Resonator response is then recorded as a function of excitation frequency.

As can be seen, McFarland does not utilize the probes to transmit force from the sample to the sensor, but rather utilizes resonance and/or changes in resonance frequency of the probe to measure certain properties of the sample. Unlike the invention of McFarland, there is a physical linkage between the material and the sensor such that a mechanical perturbation of the material by the probe results in a force on the sensor.

With respect to claim 50, McFarland does not disclose the measurement of a property as a function of displacement of the probe or the sample. Further, with respect to claim 59, McFarland does not disclose a method which utilizes a probe with a test fixture. For at least these reasons, the present claims are allowable over the applied art. Withdrawal of the rejection is respectfully requested.

Rejection of claims 49-55 under 35 U.S.C. 102(e)

The Examiner rejected claims 49-55 under 35 U.S.C. §102(e) as being anticipated by Mansky. This rejection is traversed.

Contrary to the assertion of the Examiner, Mansky does not monitor with a sensor a force exerted on the probe by the material. Rather, Mansky discloses no more than McFarland does in this respect; namely, the use of electrical pulses and changes in electrical pulses to measure changes in resonance frequency of a resonator. Indeed, the limit of the Mansky disclosure on this point is the disclosure McFarland and Matsiev. At column 37, lines 25-28, Mansky references U.S. Application 09/133,171 to Matsiev. This application matured into the Matsiev reference discussed herein and Matsiev is a continuation-in-part of McFarland. Thus, Mansky adds nothing on this point. Consequently, similar to as discussed above, Mansky

does not disclose the use of a physical linkage between the material and the sensor. For essentially the same reasons stated above, claims 50 and 59 are also not taught by Mansky. For at least these reasons, the present claims are allowable over the applied art. Withdrawal of the rejection is respectfully requested.

Rejection of claims 49-55 under 35 U.S.C. 102(e)

The Examiner rejected claims 49-55 under 35 U.S.C. §102(e) as being anticipated by Matsiev. This rejection is traversed.

For essentially the same reasons stated above with respect to McFarland, Matsiev does not disclose the present invention. The Examiner's attention is drawn to column 7, lines 57-62, where Matsiev contains a very similar discussion of the operation of the resonators as is contained in McFarland:

> The tuning fork resonator 20 is preferably coupled with a network analyzer 28, such as a Hewlett-Packard 8751A network analyzer, which sends a variable frequency input signal to the tuning fork resonator 20 to generate the resonator oscillations and to receive the resonator response at different frequencies.

As can be seen, Matsiev does not utilize the probes to transmit force from the material to the sensor, but rather utilizes resonance and/or changes in resonance frequency of the probe to measure certain properties of the sample. Unlike the invention of Matsiev, in the present invention there is a physical linkage between the material and the sensor such that a mechanical perturbation by the probe results in a force on the sensor. In addition, Matsiev does not disclose does not disclose the measurement of a property as a function of displacement of the probe or the material. Further, with respect to claim 59, Matsiev does not disclose a method which utilizes a probe with a test fixture. For at least these reasons, the present claims are allowable over the applied art. Withdrawal of the rejection is respectfully requested.

CONCLUSIONS

In view of Applicants' amendments and remarks, the Examiner's rejections are believed to be rendered moot. Accordingly, Applicants submit that the present application is in condition for allowance and requests that the Examiner pass the case to issue at the earliest convenience. Should the Examiner have any question or wish to further discuss this application, Applicant requests that the Examiner contact the undersigned at cvoci@patentco.com or (248) 593-9900.

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